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In re Application of :
James A. Burke et al :
Serial No.: 09/998,718 : PETITION DECISION
Filed: November 1, 2001 :
Attorney Docket No.: 17400CIP(HL) :

This is in response to the petition under 37 CFR 1.181, filed October 4, 2004, requesting withdrawal of the finality of the last Office action. The delay in acting on this petition is regretted, however it was only recently brought to the attention of the deciding authority.

BACKGROUND

A review of the file history shows that the examiner mailed a non-Final Office action to applicants on September 23, 2003, setting forth as the only ground of rejection a rejection under 35 U.S.C. 112, first paragraph, for lack of written description of the claimed invention. Applicants replied on December 22, 2003, canceling the non-elected claims, but making no other amendments to the original claims, and addressing the rejection appropriately.

The examiner then mailed a Final Office action to applicants on April 20, 2004, setting forth as the only ground of rejection a rejection under 35 U.S.C. 112, first paragraph, for lack of enablement, not lack of written description. Applicants replied on July 23, 2004, addressing the rejection appropriately, and also arguing that the finality of the Office action was premature as it contained a new ground of rejection not necessitated by applicants' amendments of which there were none.

The examiner mailed an Advisory action to applicants on September 13, 2004, denying entry of applicants' amendment on the basis that it raised new issues, but provided no explanation thereof. Applicants then filed this petition on October 4, 2004, requesting finality of the last Office action be withdrawn as improper. Applicants have since filed a Notice of Appeal.

DISCUSSION

A review of the examiner's actions shows that while the application was rejected under the same section of the statute in each Office action noted above, the basis for the rejection in each action

was different. 35 U.S.C. 112, first paragraph, defines several criteria which applicant must meet in order to satisfy the requirements thereof. Two of these are written description and enablement. These criteria are different and satisfaction of one does not automatically mean satisfaction of the other. Further, inasmuch as applicants did not amend their claims in response to the first Office action the examiner's institution of a new ground of rejection (enablement) in a second Office action and making the action a Final Office action is in direct conflict with M.P.E.P. 706.07(a).

Additionally, the examiner's refusal to enter the amendment after Final Office action without an explanation as to non-entry is contrary to Office policy.

The renewed petition is **GRANTED**. The finality of the Office action mailed April 20, 2004, is withdrawn. The amendment filed July 23, 2004, is entered.

The file will be forwarded to the examiner for further action not inconsistent with this decision and will take into consideration the amendment filed July 23, 2004.

The Notice of Appeal is held in abeyance. Applicants may request a refund of the Appeal Fee filed with the Notice of Appeal or, should the application be properly finally rejected reinstate the Appeal by filing a new Notice of Appeal without additional fee.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number, 571-273-8300.



Bruce M. Kisliuk
Director, Technology Center 1600